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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,272	10/29/2001	Bobby Neal Glover	PU3126US2	8388

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[REDACTED] EXAMINER

CRANE, LAWRENCE E

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1623

DATE MAILED: 12/16/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>10/007,272</b>	Applicant(s) <b>Glover et al.</b>
	Examiner <b>L. E. Crane</b>	Group Art Unit <b>1623</b>

- THE MAILING DATE of this communication appears on the cover sheet beneath the correspondence address -

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE --3-- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be filed after six months from the date of this communication.
- If the prior for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 USC §133).

## Status

- Responsive to communication(s) filed on -10/29/01 (amdt A and IDS)-.  
 This action is **FINAL**.  
 Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- Claims --11, 14 and 16-21-- are pending in the application. Claims -1-10, 12-13 and 15- have been cancelled.  
 Of the above claim(s) --[]-- is/are withdrawn from consideration.  
 Claim(s) --[]-- is/are allowed.  
 Claims --11, 14 and 16-21-- are rejected.  
 Claim(s) --[]-- is/are objected to.  
 Claim(s) --[]-- are subject to restriction or election requirement.

## Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.  
 The proposed drawings, filed on -10/29/01- are  approved  disapproved.  
 The drawing(s) filed on -[]- is/are objected to by the Examiner.  
 The specification is objected to by the Examiner.  
 The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119(a)-(d)

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).  
 All  Some  None of the CERTIFIED copies of the priority documents have been received.  
 received in Application No. (Series Code/Serial Number) -[]-.  
 received in the national stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* Certified copies not received: -[]-.

## Attachment(s)

- |   |   |
|---|---|
| <input checked="" type="checkbox"/> Information Disclosure Statement(s), PTO-1449, Paper No(s). <u>--05--</u> | <input type="checkbox"/> Interview Summary, PTO-413                     |
| <input checked="" type="checkbox"/> Notice of Reference(s) Cited, PTO-892                                     | <input type="checkbox"/> Notice of Informal Patent Application, PTO-152 |
| <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review, PTO-948                              | <input type="checkbox"/> Other: <u>-[]-</u>                             |

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Claims 1-10, 12-13 and 15 have been cancelled, claims 11 and 14 have been amended, and new claims 16-21 have been added as per the preliminary amendment filed October 29, 2001. An Information Disclosure (IDS) statement has been received together with all cited references.

Claims 11, 14 and 16-21 remain in the case.

Claims 11, 14, 16-17 and 19-20 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 11, 14, 16-17 and 19-20, the term "substantially" is per se indefinite and its cancellation is therefore respectfully requested.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F. 2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. §1.78(d).

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Effective January 1, 1994, a registered attorney or agent or record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. §3.73(b).

Claims 11 and 16-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-10 of U. S. Patent No. 6,469,160 (PTO-892 ref. A). Although the conflicting claims are not identical, they are not patentably distinct from each other because the active ingredient of the compositions claimed is identical, the only variations being in the presence or absence of pharmaceutically acceptable carriers.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

- “A person shall be entitled to a patent unless -
- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.”
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.”
- (e) the invention was described in
- (1) an application for patent described under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application filed under this subsection of a national application published under section 122(b)

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only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

5                     (2) a patent granted on an application by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a)."

Claims 11, 14 and 16-21 are rejected under 35 U.S.C. §102(e) as being anticipated by Chamberlain et al. '832 (PTO-1449 ref. AK).

10                  Applicant is referred to claims 20-23 (pharmaceutical compositions) and claims 26-28 (methods of treating herpes viral infections) of the '832 reference wherein the instant claimed subject matter has been anticipated. The particular crystal structure, mixture of crystal structures, or absence of crystal structure of the active 15 ingredient is deemed to be irrelevant to the pharmaceutical efficacy thereof because the pharmaceutical activity of the active ingredient is a function of the molecular structure(s) adsorbed by the cells contacted by the composition and/or the crystal structure is destroyed by dissolution of the crystalline solid by the pharmaceutically acceptable 20 carrier.

25                  This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §§102(f) or (g) prior art under 35 U.S.C. §103(a).

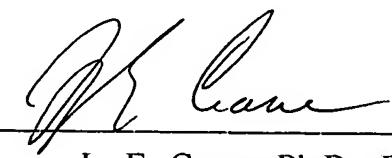
5        Papers related to this application may be submitted to Group 1600 via facsimile transmission(FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30, November 15, 1989). The telephone numbers for the FAX machines operated by Group 1600 are **(703) 308-4556** and **703-305-3592**.

10      Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E. Crane whose telephone number is **703-308-4639**. The examiner can normally be reached between 9:30 AM and 5:00 PM, Monday through Friday.

15      If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson, can be reached at (703)-308-4624.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is **703-308-1235**.

20      LECrane:lec  
**12/13/02**

  
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L. E. Crane, Ph.D., Esq.  
Patent Examiner  
Technology Center 1600

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